

Application No. 09/995,287  
Reply to Office Action of October 21, 2005

Docket No.: 65678-0043

## **I. REMARKS**

This amendment is intended to be fully responsive to the Office Action having a mailing date of October 21, 2005, wherein claims 36-62 are rejected. Applicants have carefully reviewed the Office Action and thank the Examiner for the detailed review of the pending claims. Claims 36 and 38 have been amended. By way of this amendment, no new matter has been added. Applicants respectfully request reconsideration of the present application in view of the above amendment and the following remarks.

## **II. ARGUMENT**

### **A. Claim Objections**

Claims 43, 44, 52, 53, 61, and 62 are objected under 37 CFR 1.75(c). Applicants submit that the aforementioned claims are proper dependent claims. Applicants traverse the objection.

MPEP § 608.01(n), under the heading "II. Treatment Of Improper Dependent Claims," states "[c]laims which are in improper dependent form for failing to further limit the subject matter of a previous claim should be objected to under 37 CFR 1.75(c) by using form paragraph 7.36." However, MPEP § 608.01(n), under heading "III. Infringement Test," states "[a] dependent claim does not lack compliance with 35 U.S.C. 112, fourth paragraph, simply because there is a question as to (1) the significance of the further limitation added by the dependent claim, or (2) whether the further limitation in fact changes the scope of the dependent claim from that of the claim from which it depends. The test for a proper dependent claim under the fourth paragraph of 35 U.S.C. 112 is whether the dependent claim includes every limitation of the claim from which it depends. The test is not one of whether the claims differ in scope."

Thus, the addition of a condition to a limitation of an independent claim does not remove the limitation from the independent claim. Indeed, the addition of a condition now further limits the claim by including a further limitation. Dependent claim 43, for example, includes a further limitation to the "prompting" step of independent claim 36. The "prompting" step of claim 36 is not deleted or replaced. As stated above, the test for proper dependency "is whether the dependent claim includes every limitation of the claim from which it depends." (See MPEP § 608.01(n), under heading "III. Infringement Test"). Under the "infringement test" analysis,

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dependent claim 43 does include each and every limitation of claim 36. Thus, dependent claim 43 passes the "infringement test" and is a proper dependent claim. Similarly, dependent claims 44, 52, 53, 61, and 62 also pass the "infringement test" analysis as defined by MPEP § 608.01(n). Therefore, the objections should be withdrawn.

**B. Claim Rejections – 35 U.S.C. § 101**

**i. Summary**

Claims 36-45 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Applicants' claims plainly recite systems and methods that produce useful, concrete, and tangible results and therefore, are clearly patentable under Section 101. *See State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998). Applicants respectfully traverse the rejection and although the rejection is improper, the Examiner's reasoning for the § 101 rejection has been fully addressed in an effort to expedite prosecution. Accordingly, for any of the foregoing reasons, the Examiner's rejection of claims 36-45 under § 101 should be reversed.

**ii. The Law**

Whether an invention is operative, and hence has utility within the meaning of § 101, is a question of fact. *In re Swartz*, 232 F.3d 862, 863 (Fed. Cir. 2000). The Patent Office establishes a *prima facie* case of lack of utility by "showing that one of ordinary skill in the art would reasonably doubt the asserted utility[.]" *In re Brana*, 51 F.3d 1550, 1566 (Fed. Cir. 1995) (Discussing § 101 and § 112 rejections in detail with respect to utility requirements). The Federal Circuit has held that ideas that produce a "useful, concrete, and tangible result," are patentable. *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). In the first instance, the Examiner must establish that a person of ordinary skill in the art would reasonably doubt the asserted utility. *Brana*, 51 F.3d at 1566. Then, the burden shifts to the Applicant to substantiate their presumptively correct disclosure. *Brana*, 51 F.3d at 1566-1567.

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Further, post *Lundgren*, new standards were promulgated in the form of guidelines. These standards include conditions such as “ [when] determining whether the claim is for a ‘practical application,’ the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is ‘useful, tangible and concrete.’” (Emphasis in original); (See United States Patent and Trademark Office 10/26/05 Interim Guidelines at 20); (See *Ex parte Lundgren*, Appeal No. 2003-2088 (BPAI 2005)).

The USPTO’s official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP §2107. (See 10/26/05 Interim Guidelines at 20-21).

Further, “[t]he tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had “no substantial practical application.”).” (See 10/26/05 Interim Guidelines at 21).

“Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. *In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is “irreproducible” claim should be rejected under section 101). The opposite of “concrete” is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether that process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary artisan in that field. An appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, where the invention cannot operate as intended without undue experimentation.” (See 10/26/05 Interim Guidelines at 22).

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iii. Arguments

Claim 36 is directed to:

“[a] method for utilizing a wireless communications system having a wireless infrastructure and a wireless device associated with the asset, said method comprising:

receiving an operator identifier from an operator of the asset;

prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator;

receiving a response to the question; and

storing the response to the question.”

(Emphasis added). In the first instance, the Examiner has failed to establish that a person of ordinary skill in the art would reasonably doubt the asserted utility. (See *Brana* above).

Further, the claim provides guidance for the asserted utility of the claims when properly read in context with the application. For example, “tracking and enforcing business policies and government requirements relating to the authorization, certification, and training of specific users with respect to specific assets, such as a fleet of industrial equipment, so as to maximize productivity and to reduce operating costs and administrative burdens.” (See ¶ [0011]; Summary). Thus, the claimed invention is “useful.”

The claimed invention is also tangible as it produces a “real-world result” in the “storing the response to the question.” This response has practical application to the utility noted above, and may be used for, but is not limited to, determining responses to a checklist as is described in the specification. (See ¶ [0079]). Thus, the claimed invention is tangible.

Further, although the “concrete” nature has not been doubted, the claimed invention is “concrete” because the outcome of the response is repeatable.

Thus, claim 36 produces a concrete, tangible and useful result as defined by the 10/26/05 Interim Guidelines. Therefore, the § 101 rejection should be withdrawn. Further, claims 37-45 were rejected, as they depend from claim 36. For at least the same reasons as claim 36, the rejection of claims 37-45 should be withdrawn.

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**C. Claim Rejections – 35 U.S.C. § 112, First Paragraph**

**i. Summary**

Claims 36-62 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirements. Claims 37-45, 47-54, and 56-62 are also rejected under 35 U.S.C. § 112, second paragraph, as they depend from claims 36, 45 and 55, respectively. Applicants respectfully traverse the rejections.

**ii. The Law**

Section 112, first paragraph, requires that “[t]he specification shall contain a written description of the invention.” 35 U.S.C. § 112. “The written description requirement is separate and distinct from the enablement requirement” of Section 112. (MPEP § 2161 (citing *In re Barker*, 559 F.2d 588, 194 USPQ 470 (CCPA 1977), *cert. denied*, 434 U.S. 1064 (1978); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562, 19 USPQ2d 1111, 1115 (Fed. Cir. 1991)). If the Examiner believes that the specification fails to meet the written description requirement, the Examiner bears the burden “of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant’s disclosure a description of the invention defined by the claims.” (MPEP § 2163.04). Moreover, the Examiner should not require that “[t]he subject matter of the claim . . . be described literally (*i.e.*, using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” (MPEP § 2163).

Here, the Examiner has done no more than assert (wrongly, as discussed below) that the specification does not describe certain recited claim elements. The Office Action provides absolutely no explanation as to why the specification would not have conveyed possession of the invention to one of ordinary skill in the art. At least because the Examiner fails to meet the burden of showing that Applicants have not met the written disclosure requirement of Section 112, the rejection of claims 36-62 under Section 112, first paragraph, should be reversed.

Further, Applicants’ Specification clearly does meet the requirements of the written description requirement of Section 112, first paragraph. As the MPEP explains:

[T]he fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. *See, e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). An applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words,

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structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1563, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). Possession may be shown in a variety of ways including description of an actual reduction to practice, or by showing that the invention was "ready for patenting" such as by the disclosure of drawings or structural chemical formulas that show that the invention was complete, or by describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention. [Citations omitted.]

(MPEP § 2163.02). As detailed below, Applicants' Specification and drawings leave no doubt that the inventors were in possession of the claimed invention, even if the claims do not always use precisely the same terminology as the Specification.

### iii. Arguments

The Examiner alleges that "Applicant does not have support for the asking of questions and the receiving and storing of responses using said wireless system (e.g. wireless device and infrastructure) (claims 36, 46, and 55)." (See Office Action, Page 3). However, as described in the specification and the drawings, the wireless infrastructure does support the claims. For example, Figure 3 shows the wireless network 42 connecting to each asset 31 by a communication system 34. Further, Figure 9 shows the same wireless communication system 34 in an authentication scenario. Additionally, the specification clearly teaches

"a communication interface 220 may even be used to complete an interactive asset checklist as discussed above before and after asset operation by each user 85."

(See ¶ [0096]). In yet another section of the specification, the wireless infrastructure is not used simply for the tracking of assets:

"Another advantage of such bi-directional communication is that data in the form of new commands, program updates, instructions, and the like can be sent to the data acquisition units 32 from the receiver 35. In some instances, such as when a data acquisition unit 32 is in generally continuous communication with a receiver 35, a user of the forklift 31 can be prompted to provide certain information for transmission to the receiver 35 for further analysis."

(See ¶ [0041]).

More specifically, the specification describes in detail the objected to wireless communications:

"A fault code may even be generated based on the actions of the asset operator. In a preferred embodiment of the invention, an electronic checklist 154 is completed by the asset operator on a regular basis, which may include information concerning asset performance that is more detailed than that available from a review of raw operational parameters. In accordance with OSHA requirements, for example, at the end of each shift, a forklift operator must complete a checklist concerning the performance

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of the asset during the shift. Some of the questions associated with checklist 154 are directed to maintenance issues. Therefore, in a preferred embodiment of the invention, checklist 154 would be completed electronically at the asset 31, and transmitted by way of the data acquisition device 32 to analysis controller 51 as discussed above. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a question asks if there is a hydraulic leak for a forklift and the answer is "yes", then maintenance would be appropriate."

(See ¶ [0079]; Emphasis added). Thus, independent claims 36, 46, and 55 are fully supported in the specification. The Examiners rejection is traversed. Claims 37-45, 47-54, and 56-62 were also rejected as they depend from claims 36, 46, and 55, respectively. For at least the same reasons as claims 36, 46, and 55, the rejection of claims 37-45, 47-54, and 56-62 is traversed.

**D. Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

**i. Summary**

Claims 36-62 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse the rejection.

**ii. Arguments**

**a. Claim 36**

Claim 36 has been amended to correct the Examiners rejection based on antecedent basis. Claims 37-45 were rejected as they depend from claim 36. Thus, in light of the amendment to claim 36, the rejection of claims 36-45 should be withdrawn.

**b. Claims 36, 46, and 55**

Claims 36, 46, and 55 were rejected for failing to be clear as to the scope of the claimed method to one skilled in the art. In the specification, a number of illustrative paragraphs overcome the Examiner's rejection:

"Another advantage of such bi-directional communication is that data in the form of new commands, program updates, instructions, and the like can be sent to the data acquisition units 32 from the receiver 35. In some instances, such as when a data acquisition unit 32 is in generally continuous

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communication with a receiver 35, a user of the forklift 31 can be prompted to provide certain information for transmission to the receiver 35 for further analysis."

(See ¶ [0041]). Additionally:

"A fault code may even be generated based on the actions of the asset operator. In a preferred embodiment of the invention, an electronic checklist 154 is completed by the asset operator on a regular basis, which may include information concerning asset performance that is more detailed than that available from a review of raw operational parameters. In accordance with OSHA requirements, for example, at the end of each shift, a forklift operator must complete a checklist concerning the performance of the asset during the shift. Some of the questions associated with checklist 154 are directed to maintenance issues. Therefore, in a preferred embodiment of the invention, checklist 154 would be completed electronically at the asset 31, and transmitted by way of the data acquisition device 32 to analysis controller 51 as discussed above. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a question asks if there is a hydraulic leak for a forklift and the answer is "yes", then maintenance would be appropriate."

(See ¶ [0079]; Emphasis added). Thus, one of ordinary skill in the art will understand the scope of the claims including the "prompting" limitation. Thus, the Examiner's rejection with respect to claim 36 is traversed. The Examiner has also rejected claims 46 and 55 for reciting "similar language." (See Office Action, Page 4). Thus, for at least the same reasons as claim 36, claims 46 and 55 are in condition for allowance. Further, claims 37-45, 47-54, and 56-62 were rejected as they depend from claims 36, 46, and 55, respectively. For at least the same reasons as claims 36, 46, and 55, claims 37-45, 47-54, and 56-62 are in condition for allowance.

**c. Claim 38**

Claim 38 has been amended. Thus, the Examiners' rejection is moot and should be withdrawn.

**d. Claim 39**

Claim 39 was rejected because the Examiner alleges that one of ordinary skill in the art would find the "new" question unclear. (See Office Action, Page 5). The specification provides background on the nature of presenting a checklist having question items:

"[C]hecklist 154 would be completed electronically at the asset 31, and transmitted by way of the data acquisition device 32 to analysis controller 51 as discussed above. The information would be analyzed to determine if an OSHA/repair need is identified. Preferably, the analysis is automated in accordance with a comparison of the operational status with pre-determined rules. For example, if a



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question asks if there is a hydraulic leak for a forklift and the answer is "yes", then maintenance would be appropriate."

(See ¶ [0079]). Additionally,

"[o]nce data related to asset 31 and user 85 is located, system 30 determines if user 85 is an authorized user for asset 31 at decision point 216, or if the asset 31 itself is available for user at decision point 218 in accordance with pre-determined rules or considerations such as those noted above. If authorization is not granted, a communication interface 220 associated with asset 31 preferably gives the reason for the denial and the steps required to obtain authorization 222. It may even be possible to use communication interface 220 to provide interactive training and certification under some circumstances. As suggested above, a communication interface 220 may even be used to complete an interactive asset checklist as discussed above before and after asset operation by each user 85. Finally, even if approval is given, confirmation as well as special instructions or information of importance to user 85, collected at point 224 (e.g., remaining access time, timing for re-training or re-certification, or next scheduled maintenance) may be displayed to the user. The ways in which the authorization subsystem 200 determines whether a user is authorized at 216 or determines asset available at 218 is described generally in greater detail below, in the discussion relating to Fig. 11.

(See ¶ [0096]; Emphasis added).

For comparison, claim 39 requires:

"receiving a new question by the wireless device from the wireless infrastructure; and updating the question."

Therefore, the specification clearly describes that the "new" question may encompass a multitude of questions including, but not limited to, different messages and modified messages. Thus, the Examiner's rejection of claim 39 is traversed.

**e. Claim 43**

Claim 43 was rejected allegedly because "according to the language of claim 36, it has already been determined that the operator has answered in the affirmative regarding 'prompting'." (See Office Action, Page 5). Applicants note that the arguments above with respect to the Examiner's claim objections are equally applicable here.

To reiterate Applicants response to the claim objections above, claim 43 adds a condition to a limitation of the independent claim but does not remove the independent claim limitation. Claim 43 further limits independent claim 36. However, the Examiner's logic would have the independent claim evaluated first, then dependent claims. As stated above, claim 43 further limits claim 36 and the claims should be read in whole. Thus, the Examiner's rejection is

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traversed and claim 43 is in condition for allowance. Further, the Examiner rejected claims 44, 52, 53, 61, and 62 is based on "similar language" in the claims. (See Office Action, Page 5). Thus, for at least the same reasons as the "similar language" of claim 43, claims 44, 52, 53, 61, and 62 are in condition for allowance.

**E. Claim Rejections – 35 U.S.C. § 103**

**i. Summary**

Claims 36-62 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,148,297 to Swor et al. ("Swor") in view of U.S. Patent No. 5,915,973 to Hoehn-Saric et al. ("Hoehn"). Applicants respectfully traverse the rejections.

**ii. The Law**

MPEP § 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: "To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2143. A case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP § 2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), *W.L. Gore and Associates, Inc. v. Garlock, Inc.* 220 USPQ 303 (Fed. Cir., 1966). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

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Independently of the cited prior art's lack of teaching of claim elements in each of the independent claims, Applicants respectfully traverse the 103(a) rejection because there are no suggestions, motivations, or objective reasons to combine the cited reference with the knowledge of ordinary skill in the art to form "a simulated fleet in accordance with the instant claim." (See Office Action, Page 6). "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed. Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

*In re Oetiker* further provides that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). "The Examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998) (emphasis added).

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the Examiner must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references"); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); *ACS Hosp. Sys. v. Montefiore*

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*Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination”); *accord*. MPEP § 2143.

It is established law that one “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *Ecolchem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

iii. Arguments

a. Independent Claim 36

Claim 36 is directed to:

“[a] method for utilizing a wireless communications system having a wireless infrastructure and a wireless device associated with the asset, said method comprising:  
receiving an operator identifier from an operator of the asset;  
prompting, independent of an active communication link between the wireless device and wireless infrastructure, a question related to operational status of the asset for the operator;  
receiving a response to the question; and  
storing the response to the question.”

(Emphasis added).

However, the combination of Swor and Hoehn do not recite each and every claim limitation. For example, neither Swor nor Hoehn disclose “an operator identifier from an operator of the asset.” (Emphasis added). Further, the combination does not disclose a “wireless device” or a “wireless infrastructure.” The Examiner has pointed to a passage from Swor that allegedly anticipates the “wireless device” in the Office Action. (See Swor; Col. 4, Lines 45-

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52). However, Swor merely recites the use of a "personal digital assistant." Indeed, there is no disclosure in Swor related to wireless connectivity. Applicant notes that it is improper to read recent technological improvements into an earlier dated reference. Here, it appears that the Examiner is attempting to read the term "wireless" into a personal digital assistant. However, Swor does not teach the wireless technology. Thus, use of a personal digital assistant does not anticipate a "wireless device" and a "wireless infrastructure."

Additionally, the Examiner cites a passage from Hoehn that allegedly anticipates the required "prompting, independent of an active communication link between the wireless device and wireless infrastructure." (See Hoehn; Col. 8, Lines 52-56). However, Hoehn merely describes that "test question data is communicated to remote test site 3." (See Hoehn; Col. 8, Lines 52-56). Hoehn does not disclose a wireless device or a wireless infrastructure. Further, the Examiner points to the same passage in Hoehn to anticipate the required "prompting, independent of an active communication link" of claim 36. (See Hoehn; Col. 8, Lines 52-56). However, Hoehn does not disclose and does not contemplate the required limitation of "prompting, independent of an active communication link." Indeed, Hoehn does not contemplate communication link activity.

Further, claim 36 requires "a question related to operation status of the asset." Neither Swor nor Hoehn disclose the prompting of such a question.

Thus, because the combination of Swor and Hoehn does not disclose each and every limitation, claim 36 is in condition for allowance. Further, claims 37-45 depend from claim 36. Therefore, for at least the same reasons as claim 36, claims 37-45 are in condition for allowance.

**b. Independent Claims 46 and 55**

Independent claims 46 and 55 include limitations similar to claim 36. These limitations are also absent from the combination of Swor and Hoehn. Thus, for at least the same reasons as similar limitations of claim 36, independent claims 46 and 55 are in condition for allowance. Further, claims 47-54 and 56-62 depend from claims 46 and 55, respectively. Thus, for at least the same reasons as claims 46 and 55, claims 47-54 and 56-62 are in condition for allowance.

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**c. Claims 37, 47, and 56**

Claim 37 requires:

“determining that an active communication link between the asset and wireless infrastructure exists;  
and

transmitting the stored response to the wireless infrastructure from the wireless device if an active communication link exists, otherwise, maintaining the response to the question.”

(Emphasis added).

The Examiner apparently takes official notice of the claim limitations of “determining that an active communication link between the asset and wireless infrastructure exists.” Such a taking of official notice is improper without support. (See below with respect to claim 39). Additionally, the limitation is not anticipated by Swor and Hoehn. Further, the required limitation of “transmitting the stored response to the wireless infrastructure from the wireless device if an active communication link exists” is not anticipated by the combination of Swor and Hoehn.

Thus, because Swor and Hoehn do not disclose each and every limitation, claim 37 is in condition for allowance. Additionally, claims 47 and 56 include similar claim limitations. Thus, the same arguments apply to claims 47 and 56. Thus, claims 47 and 56 are in condition for allowance.

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**d. Claims 39, 48, and 57**

Claims 39, 48, and 57 were rejected as the Examiner:

“takes Official Notice of the updating of exam questions, for example by changing questions, in order to introduce new topics, emphasize or de-emphasize material, and the memorization of questions.”

(See Office Action, Page 7).

With respect to the taking of Official Notice, Applicants respectfully request that the Examiner provide the basis to support the taking of such notice if any rejections relying on official notice were to be maintained. As clearly dictated by the MPEP and supporting authority, it is “not [] appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” MPEP 2144.03 (emphasis in original).

Thus, absent a basis for supporting the Examiner’s taking of official notice, the rejection of claims 39, 48, and 57 should be withdrawn.

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Docket No.: 65678-0043

**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65678-0043 from which the undersigned is authorized to draw.

Dated: January 23, 2006

Respectfully submitted,

By 

Michael B. Stewart

Registration No.: 36,018

RADER, FISHMAN & GRAUER PLLC

39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304

(248) 594-0633

Attorney for Applicant

R0326231